

REMARKS

This Preliminary Amendment constitutes the proper Submission with the Request for Continued Examination pursuant to 37 C.F.R. § 1.114 being concurrently filed and fully complies with M.P.E.P. § 706.07(h)(II).

Also, a Petition for Extension of Time is being concurrently filed with this Preliminary Amendment. Thus, this Preliminary Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and specification and the following remarks.

Status of the Claims

In the present Preliminary Amendment, claims 1-8 have been amended and claims 9-11 have been added. Thus, claims 1-11 are pending in the present application.

No new matter has been added by way of these amendments because each amendment is supported by the present specification and/or is minor in character. For the amendments to claims 1 and 4, subject matter is actually being deleted (e.g., the scope of “m” in claim 1). Also with regard to claim 4, this claim referred to claim 1 as well as to formula I.1 (of claim 2), but did actually not refer to claim 2. Claim 4 now depends on claim 1 or claim 2. Otherwise, the changes to claims 1 and 4 are minor in character (e.g., correct grammatical errors). With this amendment to claim 1, claim 5 was appropriately amended. Further, claim 2 now appears in independent form. Also, a period has been added to the end of claim 6 and the change to claim 3 is obviously minor in character. The changes to claims 7 and 8 are obviously minor in character.

Thus, many of these amendments are clarifying in nature. By amending these terms in order to clarify the claimed invention (e.g., "A" to "The"), Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

For new, dependent claims 9-11, Applicants note that the possible halogen substituents are being deleted. Support for these new claims is obviously found in the base claims. No new matter has been added.

Also, Applicants' representative previously contacted the Examiner to clarify the status of pending claim 6. The Examiner has stated that claim 6 has been found allowable over the prior art of record. Thus, the claim is objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form.

The amendment to the specification (the title) does not add new matter ("alkynyl" replaced with "alkynyl").

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

Claims 1, 3, 4, 5, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pees *et al.* '561 (U.S. Patent No. 5,965,561; see paragraphs 4-8 of the Office Action).

Also, claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over J. Tormo I Blasco *et al.* '460/'664 (U.S. Application No. 10/474,460; now U.S. Patent No. 7,105,664) (see paragraphs 9-13 of the Office Action).

Applicants respectfully traverse and reconsideration is based on the following remarks. Overall, Applicants do not concede that a *prima facie* case of obviousness has been established with respect to any of these rejections.

The Rejection in View of Pees *et al.* '561

In the response dated January 9, 2007 (at page 10), Applicants previously asserted:

. . . A compound is anticipated only when one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). For a compound to be "at once envisaged", one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. *Id.* In the instant case, groups "R¹" and "R²" in Pees '561 can each be hydrogen, alkyl, alkynyl, alkadienyl, aryl, bicycloalkyl or heterocyclyl. Optionally, these groups could further be substituted or may form a ring. Pees '561 does not provide any example specifically utilizing Applicants' formula (I), nor in any other way suggest this specific formula. Furthermore, Pees '561 discloses preferred embodiments, none of which lists alkynyl as a preferred R¹ or R² group (see col. 4, lines 7-10 and 20-47). In particular, where compounds with a good fungicidal activity are listed, alkynyl is not mentioned (see col. 5, lines 16-39). Further, no specific synthetic pathway leading to alkynyl compounds is disclosed in Pees '561.

However, in the outstanding Office Action, the Examiner finds such arguments as unpersuasive. More specifically, in paragraph 6 of the Office Action, the Examiner states: "This is simply not true because Pees *et al.* '561 expressly suggest alkynyl in their preferred embodiments at line 46, column 3."

A proper obviousness inquiry requires consideration of three factors, which includes whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process). *See* M.P.E.P. § 2143. Also, the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. *See KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385, 1395 (U.S. 2007). But with regard to the present application, Applicants note that while the courts have adopted a more flexible teaching/suggestion/motivation (TSM) test in connection with the obviousness standard based on the *KSR v. Teleflex* case which involved a mechanical device in a relatively predictable technological area, it remains true that, despite this altered standard, the courts recognize inventors face additional barriers in relatively unpredictable technological areas. This was the case in *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007) (since TSM test can provide helpful insight if it is not applied as rigid and mandatory formula, and since, in cases involving new chemical compounds, it remains necessary to identify some reason that would have led chemist to modify known compound, in particular manner, in order to establish *prima facie* obviousness of new compound).

Here, the cited Pees *et al.* '561 reference discloses at column 3, line 41 to column 4, line 2 an extremely large sub-genus of compounds which encompasses nearly the entire large genus of compounds disclosed generally. This paragraph states that the invention "especially" relates to these compounds which falls short of the clearly indicated "preferred" groups for substituents R¹ and R² which are indicated at, for example, column 4, lines 7-10 and 20-33. Applicants also

note that Pees *et al.* '561 fails to disclose any specific examples of compounds wherein R¹ or R² falls within the alkynyl definition of the instantly pending claims. Thus, the Examiner's statement that Pees *et al.* '561 teaches the alkynyl substituents of the present invention as preferred is not correct. Instead, Pees *et al.* '561 states that its invention especially relates to groups R¹ and R² including alkynyl, but alkynyl is clearly not listed as being "preferred".

Thus, there is no lead compound such that one of ordinary skill in the art would even know how to start some experimentation in order to achieve what is being claimed. As explained in *Takeda Chemicals*, it remains necessary to identify some reason that would have led chemist to modify known compound, in particular manner, in order to establish *prima facie* obviousness of a new compound. Even if the Examiner believes that there is a preference disclosed in Pees *et al.* '561, Applicants note the size of the disclosed genus in the reference.

Furthermore, Applicants respectfully request reconsideration in view of the amendment to claim 1 as presented herein. In addition, the amendments of claims 1 and 5 should overcome the rejection over Pees *et al.* '561. This is because only three groups for "L_m" are possible as substituents on the phenyl group, one of which has to be in the ortho position. In other words, there is no longer any generic overlap with the disclosure of the cited Pees *et al.* '561 document. Since the pentafluorophenyl group is the gist of the invention disclosed in Pees *et al.* '561, this reference definitely does not provide any motivation to ship the pentafluorophenyl group, replace it with the specific phenyl group of the invention and select an alkynyl containing groups as R². Again, even under *KSR Int'l*, there still has to be a basis to arrive at the teaching, suggestion or motivation.

Finally, regarding paragraph 7 of the Office Action, Applicants respectfully maintain their position. The reference to the activity against *Puccina Recondita* not being claimed is improper, since such activity is an inherent function of the claimed compounds. Also, under *Takeda Chemicals*, the fact that Pees *et al.* '561 fails to disclose such activity goes against the requisite teaching, suggestion or motivation.

The Rejection in View of i Blasco *et al.* '664

The patent of Tormo I Blasco *et al.* '664 is now cited under 35 U.S.C. § 103(a) against claims 2-4. The Examiner's reasoning is based on a certain scope of formula I.1 in pending claim 2, where "R²¹" can be halomethyl and "R²³" is a C₂-C₁₀-alkynyl group. In Tormo I Blasco *et al.* '664, R¹ of formula (I) can be C₂-C₁₀-alkynyl (although there is no example for this), and R² is C₂-C₈-fluoroalkyl, which could be fluoroethyl. According to the Examiner, it would have been obvious to choose the alkynyl group as R¹ and replace the fluoroethyl group R³ with a fluoromethyl group. The Examiner also asserts that the requisite motivation can be found in Section [0040] of Tormo I Blasco *et al.* '460, where it is stated that "a preferred alkyl moiety is an ethyl or especially a methyl group."

However, Applicants respectfully submit that such a conclusion is clearly based on hindsight because:

- For group R³ (fluoro)methyl is specifically excluded; and
- R³ is a haloalkyl moiety, and preferred haloalkyl moieties are 2,2,2-trifluoroethyl or 1,1,1-trifluoroprop-2-yl group, and not e.g., a trifluoromethyl group.

Furthermore, in sections [0153] to [0160] of Tormo I Blasco *et al.* '460, comparison trials are presented, wherein compounds according to Tormo I Blasco *et al.* are compared with prior art compounds where R³ (of Tormo I Blasco *et al.* '664) is replaced with a CF₃-group. These trials (in none of which R¹ is an alkynyl group) show that it is less advantageous to have a trifluoromethyl group in this position. Accordingly, Applicants respectfully submit that the USPTO has relied on only certain parts of the Tormo I Blasco *et al.* '664 reference, which are not in line with the actual teaching of Tormo I Blasco *et al.* '664. Any cited reference used for a rejection under 35 U.S.C. § 103(a) must be considered in its entirety, *i.e.*, as a whole. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Also, Applicants note *Grain Processing Corp. v. American Maize-Products Co.*, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988), which states: "Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'" A trifluoromethyl group is not even preferred in Tormo I Blasco *et al.* '664.

Applicants also request separate consideration of new claims 9-11.

Issues of Obviousness-Type Double Patenting

Claims 1-5 and 7-8 stand rejected under the judicially created doctrine of nonstatutory double patenting, wherein the Examiner asserts that these claims are in conflict with claims 1-8 of U.S. Patent No. 6,559,151 (see paragraphs 14-17 of the Office Action).

Also, claims 1-5 and 7-8 stand rejected under the judicially created doctrine of nonstatutory double patenting as being unpatentable over claims 1-2 and 6-8 of U.S. Patent No. 7,094,894 (or copending Application Serial No. 10/513,030) (see paragraphs 18-21 of the Office Action).

Further, claims 1-5 and 7-8 stand rejected under the judicially created doctrine of nonstatutory double patenting as being unpatentable over claims 1, 12, 13, 18 and 19 of U.S. Patent No. 7,148,227 (or Application Serial No. 10/508,409) (see paragraphs 23-25 of the Office Action).

In addition, claims 1-5 and 7-8 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-7 of copending Application Serial No. 10/483,597, now U.S. Publication No. 2004/0162428 A1 (see paragraphs 26-27 of the Office Action).

Furthermore, claims 1-5 and 7-8 stand rejected under the judicially created doctrine of nonstatutory double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,038,047 (in the Office Action, the Examiner refers to USPN 7,083,047; however USPN 7,038,047 corresponds to Application Serial No. 10/483,599) (see paragraphs 28-30 of the Office Action).

Finally, claims 1-5 and 7-8 stand provisionally rejected under the judicially created doctrine of nonstatutory double patenting as being unpatentable over claims 1-10 of copending Application Serial No. 10/483,600, now U.S. Publication No. 2004/0162286 A1 (see paragraphs 31-32 of the Office Action).

Applicants herein submit Terminal Disclaimers thereby obviating all of these rejections, with the exception of the rejection in view of *Pees et al.* '151 (the first rejection listed above; see paragraphs 14-17 of the Office Action). One Terminal Disclaimer refers to the patents; the other Terminal Disclaimer refers to the copending applications.

Regarding paragraphs 14-17 of the Office Action, Formula (I) in the claims of the cited *Pees et al.* '151 reference discloses triazolopyrimidine derivatives with a CF₃ substituent in the ortho position of the phenyl ring. Substituents R¹ or R² on the amino group can be alkynyl groups; however, there is no working example for such compounds. In fact, the CF₃ group on the phenyl ring (in combination with a further substituent) is the characteristic feature of *Pees et al.* '151. Furthermore, in the present claims, haloalkyl has been excluded as substituent.

Accordingly, *Pees et al.* '151 fails to disclose all claimed features. Further, *Pees et al.* '151 clearly cannot provide any motivation to alter the characteristic feature of its own invention. As mentioned, there is even no working examples in *Pees et al.* '151 regarding R¹ or R² being an alkynyl group, and thus there is no lead compound to guide the skilled artisan to achieve the present invention. It is, therefore, believed that the claims of the present invention are patentably distinct from the claims of the cited *Pees et al.* '151 reference.

Reconsideration and withdrawal of all of these rejections are respectfully requested.

Request for Interview

Applicants herein request an Interview with the Examiner. Applicants' representative will be contacting the Examiner in about one month's time to arrange the

Interview. It is believed that this Interview will advance prosecution for this application.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: August 16, 2007

Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant